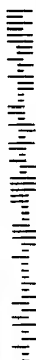


PK2



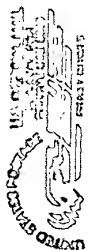
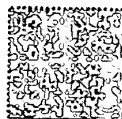
P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

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03 1A \$02.909  
0004202245 JUN 23 2004  
MAILED FROM ZIP CODE 22313



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,321	12/29/2000	Robert Walter Schreiber	52817.000126	6990
29315	7590	06/23/2004		
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190				
EXAMINER COULTER, KENNETH R				
ART UNIT 2141		PAPER NUMBER		

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JUN 25 2004

Technology Center 2100

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/750,321	SCHREIBER, ROBERT WALTER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kenneth R Coulter	2141	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 and 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                            |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)        |
| Paper No(s)/Mail Date <u>1/23/01; 1/30/03</u>  | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 6/18/03; 11/5/03; 4/5/04</u> |

## DETAILED ACTION

### *Drawings*

1. Examiner approves the changes to Figure 3B (1/29/01; paper #6).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldberg et al. (U.S. Pat. No. 6,434,543) (System and Method for Reliable Caching of Database Connections in a Distributed Application).

- 3.1 Regarding claim 1, Goldberg discloses a method for caching a network connection, comprising the steps of:

receiving a connection request for at least one first connection between at least one terminal and a server (Abstract; Fig. 3, items 306, 308; col. 5, lines 28 – 37 “The interaction of client objects 302 and 304 with server object 310 is illustrated by arrows

306 and 308”; col. 5, line 66 – col. 6, line 5 “when client 302 re-establishes a connection 306 between itself and server 310”);

establishing the at least one first connection between the at least one terminal and the server (Abstract; Fig. 3, items 306, 308; col. 5, lines 28 – 37 “The interaction of client objects 302 and 304 with server object 310 is illustrated by arrows 306 and 308”; col. 5, line 66 – col. 6, line 5 “when client 302 re-establishes a connection 306 between itself and server 310”);

requesting at least one second connection between the server and the at least one end device (Abstract; Fig. 3, items 310, 316, 320, 324; col. 5, lines 46 – 65 “**server 310 establishes a connection to one of databases 324 and 326 by requesting a connection handle** from connection manager 316.”);

establishing the at least one second connection (Abstract; Fig. 3, items 310, 316, 320, 324; col. 5, lines 46 – 65); and

maintaining a record of the at least one second connection established (Abstract; Fig. 3, item 318; col. 5, lines 46 – 65 “Connection manager 316 maintains an internal cache 318 of connections that have been opened.”).

3.2 Per claim 2, Goldberg teaches the step of receiving a disconnection request for the at least one first connection from the at least one terminal (col. 5, lines 46 – 65 “**When client 302 has finished with server 310, it drops the connection 306.**”).

3.3 Regarding claim 3, Goldberg discloses the step of disconnecting the at least one first connection (col. 5, lines 46 – 65 “**When client 302 has finished** with server 310, it **drops the connection 306.**”).

3.4 Per claim 4, Goldberg teaches the step of sustaining the at least one second connection after the at least one first connection has been disconnected (col. 5, lines 46 – 65 “).

3.5 Regarding claim 5, Goldberg discloses that the record is a list of established second connections (Abstract; Fig. 3, items 302, 310, 306, 324, 320; col. 5, lines 46 – 65 “**When client 302 has finished** with server 310, it **drops the connection 306.** However, **connection manager 316 does not release connection 320**, but instead stores the connection information including identification information for the client 302, ...”)

3.6 Per claims 6 – 20, the rejection of claims 1 – 5 under 35 USC 102(e) (paragraphs 3.1 – 3.5 above) applies fully.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER  
PRIMARY EXAMINER  


krc

<b>Notice of References Cited</b>	Application/Control No. 09/750,321	Applicant(s)/Patent Under Reexamination SCHREIBER, ROBERT WALTER	
	Examiner Kenneth R Coulter	Art Unit 2141	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,434,543 B1	08-2002	Goldberg et al.	707/2
	B	US-6,092,063 A	07-2000	Cheng et al.	707/2
	C	US-6,112,196 A	08-2000	Zimowski et al.	707/2
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



FORM PTO-1449 (REV. 7-80)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO.: 52817.000126		SERIAL NO.: 09/750,321	
LIST OF MATERIALS CITED BY APPLICANT  (Use several sheets if necessary)				INVENTOR'S NAME: Robert Walter Schreiber		EXAMINER: <del>Unknown</del> COULTER	
				FILING DATE: 12/29/00		GROUP: <del>Unknown</del> 2141	

*EXAMINER INITIAL		DOCUMENT NUMBER								DATE	NAME	CLASS	SUBCLASS	FILING DATE
JMK	A	5	8	7	3	0	8	7	2/99	Brosda et al.				
	B	6	0	0	6	2	3	4	12/99	Govindarajan et al.				
	C	6	0	1	6	4	9	3	1/00	Burrows				
	D	6	0	1	4	6	7	0	1/00	Zamanian et al.				
	E	6	0	0	6	2	3	2	12/99	Lyons				
	F	5	8	9	7	6	3	6	4/99	Kaesar				
	G	6	0	5	5	5	2	7	4/00	Badger et al.				
	H	5	9	5	6	7	3	0	9/99	Burroughs et al.				
	I	5	9	6	0	4	3	3	9/99	Fujii et al.				
	J	5	9	7	7	8	9	0	11/99	Rigoutsos et al.				
	K	6	0	0	9	4	3	5	12/99	Taubin et al.				
	L	6	0	5	2	6	8	9	4/00	Muthukrishnan et al.				
	M	5	8	9	3	1	2	0	4/99	Nemes				
	N	5	9	3	3	8	4	2	8/99	Ross				
	O	5	8	5	0	5	4	4	12/98	Parvathaneney et al.				
	P	5	8	4	2	2	2	3	11/98	Bristor				
	Q	5	9	6	3	9	6	1	10/99	Cannon et al.				
	R	5	9	9	1	7	6	5	11/99	Vethe				
	S	6	0	3	2	1	4	7	2/00	Williams et al.				
	T	5	7	5	4	8	4	9	05/98	Dyer et al.				
	U	5	8	5	2	7	1	7	12/98	Bhide et al.				
	V	5	7	4	5	7	3	7	04/98	Kayes et al.				
	W	5	9	4	0	8	5	5	08/99	Kayes et al.				
	X	5	7	9	0	8	0	4	08/98	Osborne				
	Y	5	8	7	0	5	4	6	02/99	Kirsch				
	Z	5	8	0	9	5	2	3	09/98	Kayes et al.				
	AA	5	7	8	1	7	5	7	07/98	Deshpande				
	BB	5	9	4	4	7	8	0	08/99	Chase et al.				
	CC	6	0	2	6	4	6	7	02/00	Petty				
	DD	6	0	4	7	3	5	6	04/00	Anderson et al.				
JMK	EE	5	9	6	0	4	2	3	09/99	Chaudhuri et al.				

Paper #3

FORM PTO-1449 (REV. 7-80)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO.: 52817.000126		SERIAL NO.: 09/750,321	
LIST OF MATERIALS CITED BY APPLICANT (Use several sheets if necessary)				INVENTOR'S NAME: Robert Walter Schreiber		EXAMINER: <del>Unknown</del> COULTER	
				FILING DATE: 12/29/00		GROUP: <del>Unknown</del> 2141	
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES NO
	FF						
OTHER MATERIALS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	GG						
EXAMINER Kenneth Coulter				DATE CONSIDERED 3/21/04			
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							



# Electronic Information Disclosure Statement

## SYSTEM AND METHOD FOR CACHING A NETWORK CONNECTION

Application:



09/750321

Confirmation: 6990

Applicant(s): Robert SCHREIBER

Docket

23452-125

Number:

Group Art

2143

Unit:

Examiner:

David Armand Wiley

search string:

( 5303367 or 5345587 or 5724577 or 5727196 or 5794232 or 5974418 or 5983234 or 5987472 or 6009422 or 6101500 or 6189012 or 6192373 or 6278992 or 6381605 or 6397222 or 6442566 ).pn.

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Technology Center 2100

1/30/03

paper # 7

### US Patent Documents

**Note: Applicant is not required to submit a paper copy of cited US Patent Documents**

init	Citation No.	Patent Number	Date	Bar Code	Patentee	Class	Subclass
	P01	5303367	1994-04-12		Leenstra, Sr. et al.	<del>395</del>	<del>600</del>
	P02	5345587	1994-09-06		Fehskens et al.	<del>395</del>	<del>650</del>
	P03	5724577	1998-03-03		Exley et al.	<del>395</del>	<del>611</del>
	P04	5727196	1998-03-10		Strauss, Jr. et al.	<del>395</del>	<del>602</del>
	P05	5794232	1998-08-11		Mahlum et al.	707	3
	P06	5974418	1999-10-26		Blinn et al.	707	100

✓	P07	5983234	1999-11-09		Tietjen et al.	707	103
	P08	5987472	1999-11-16		Serafin	707	104
	P09	6009422	1999-12-28		Ciccarelli	707	4
	P10	6101500	2000-08-08		Lau	707	103
	P11	6189012	2001-02-13		Mital et al.	707	103
	P12	6192373	2001-02-20		Haegeler	707	104
	P13	6278992	2001-08-21		Curtis et al.	707	3
	P14	6381605	2002-04-30		Kothuri et al.	707	100
	P15	6397222	2002-05-28		Zellweger	707	102
✓	P16	6442566	2002-08-27		Atman et al.	707	103

## Signature

Examiner Name	Date
Kenneth Latta	6/20/04

1/30/03

paper # 7



paper # 8

<b>INFORMATION DISCLOSURE CITATION IN AN APPLICATION</b>  Form PTO-1449	Docket Number	Application Number
	23452-125	09/750,321
	Applicant(s)	
	Robert Walter SCHREIBER	
Filing Date	Group Art. Unit	
December 29, 2000	2143 2141	

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## U.S. PATENT DOCUMENTS

Technology Center 2100

*EXAMINER INITIAL	REF	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
lllc	A	4,956,774	09/11/1990	Shibamiya <i>et al.</i>	707	2	
	B	5,388,196	02/07/1995	Pajak <i>et al.</i>	395	453	
	C	5,414,812	05/09/1995	Filip <i>et al.</i>	707	103R	
	D	5,568,639	10/22/1996	Wilcox <i>et al.</i>	395	600	
	E	5,630,125	05/13/1997	Zellweger	995	614	
	F	5,805,860	09/08/1998	Parham	716	12	
	G	5,875,446	02/23/1999	Brown <i>et al.</i>	707	3	
	H	6,034,697	03/07/2000	Becker	345	433	
	I	6,182,060	01/30/2001	Hedgcock <i>et al.</i>	707	1	
	J	6,191,790	02/20/2001	Bogdan	345	426	
	K	6,199,059	03/06/2001	Dahan <i>et al.</i>	707	3	
	L	6,388,592	05/14/2002	Natarajan	341	107	
	M	6,392,667	05/21/2002	McKinnon <i>et al.</i>	345	738	
	N	6,434,745	08/13/2002	Conley, Jr. <i>et al.</i>	717	177	
lllc	O	6,529,914	03/04/2003	Doan <i>et al.</i>	707	1	

## FOREIGN PATENT DOCUMENTS

	REF	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	Translations	
							YES	NO

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

lllc	P	Arie SHOSHANI, "OLAP and Statistical Databases: Similarities and Differences", <u>ACM</u> , June 1997, pages 185-196.					
lllc	Q	Michael V. MANNINO <i>et al.</i> , "Statistical Profile Estimation in Database Systems", <u>ACM Computing Surveys</u> , Vol. 20, No. 3, September 1988, pages 191-221.					
lllc	R	Wei WANG <i>et al.</i> , "An Approach to Active Spatial Data Mining Based on Statistical Information", <u>IEEE Transactions on Knowledge and Data Engineering</u> , Vol. 12, No. 5, September/October 2000, pages 715-728.					
lllc	S	Francesco M. MALVESTUTO, "A Universal-Scheme Approach to Statistical Databases Containing Homogeneous Summary Tables", <u>ACM Transactions on Database Systems</u> , Vol. 18, No. 4, December 1993, pages 678-708.					

EXAMINER	DATE CONSIDERED
Kenneth Coultar	3/21/04
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP Section 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.	



## ELECTRONIC INFORMATION DISCLOSURE STATEMENT

Electronic Version v18  
Stylesheet Version v18.0

Title of  
Invention

SYSTEM AND METHOD FOR CACHING A NETWORK  
CONNECTION

Application Number: 09/750321  
Confirmation Number: 6990  
First Named Applicant: Robert SCHREIBER  
Attorney Docket Number: 23452-125  
Art Unit: 2143  
Examiner: David Armand Wiley  
Search string: ( 5542089 or 5752241 or 5801702 or 6085188  
or 6226640 or 6347312 or 6438549 or 6466933  
or 6470330 or 6493750 or 6539383 or  
6611837 ).pn.



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Technology Center 2100

paper #9 11/5/03

### US Patent Documents

Note: Applicant is not required to submit a paper copy of cited US Patent Documents

init	Cite.No.	Patent No.	Date	Patentee	Kind	Class	Subclass
INC	1	5542089	1996-07-30	Lindsay et al.		395	600
	2	5752241	1998-05-12	Cohen		707	3
	3	5801702	1998-09-01	Dolan et al.		345	357
	4	6085188	2000-07-04	Bachmann et al.		707	3
	5	6226640	2001-05-01	Ostrovsky et al.		707	5
	6	6347312	2002-02-12	Byrne et al.		707	3
	4	6438549	2002-08-20	Aldred et al.		707	5
	8	6466933	2002-10-15	Huang et al.		707	3
	6	6470330	2002-10-22	Das et al.		707	2
	10	6493750	2002-12-10	Mathew et al.		709	220
	11	6539383	2003-03-25	Charlet et al.		707	10
INC	12	6611837	2003-08-26	Schreiber		707	100

### Remarks

Note: Remarks are not for responding to an office action.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No fee is required. Citations Nos. 1, 2, 5, and 9 were cited by the U.S. Patent Office in co-pending Application Serial No. 09/750,317, filed December 29, 2000, in an Office Action dated September 4, 2003. Citations Nos. 3, 4, 6, 7, 8, 10, and 11 were cited by the U.S. Patent Office in co-pending Application Serial No. 10/431,361, filed May 8, 2003, in an Office Action dated August 11, 2003.

Signature

Examiner Name	Date
<i>Kenneth C. Miller</i>	<i>6/20/04</i>

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Technology Center 2100

Paper #9 11/5/03



## ELECTRONIC INFORMATION DISCLOSURE STATEMENT

Electronic Version v18  
Stylesheet Version v18.0

Title of Invention	SYSTEM AND METHOD FOR CACHING A NETWORK CONNECTION
-----------------------	---

Application Number: 09/750321  
Confirmation Number: 6990  
First Named Applicant: Robert SCHREIBER  
Attorney Docket Number: 23452-125  
Art Unit: 2141  
Examiner: Kenneth R. Coulter  
Search string: ( 5754493 or 6026410 or 6081774 or 6094651  
or 6349275 or 6415250 or 6421656 or 6498921  
or 6571282 or 6629132 or 6665674 ).pn.



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Technology Center 2100

### US Patent Documents

Note: Applicant is not required to submit a paper copy of cited US Patent Documents

init	Cite.No.	Patent No.	Date	Patentee	Kind	Class	Subclass
<input checked="" type="checkbox"/>	1	5754493	1998-05-19	Al-Chalabi		367	38
<input type="checkbox"/>	2	6026410	2000-02-15	Allen et al.		707	104
<input type="checkbox"/>	3	6081774	2000-06-27	de Hita et al.		704	9
<input type="checkbox"/>	7	6094651	2000-07-25	Agrawal et al.		707	8
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<input type="checkbox"/>	5	6415250	2002-07-02	van den Akker		704	8
<input type="checkbox"/>	7	6421656	2002-07-16	Cheng et al.		707	2
<input type="checkbox"/>	8	6498921	2002-12-24	Ho et al.		434	362
<input type="checkbox"/>	9	6571282	2003-05-27	Bowman-Amuah		709	219
<input type="checkbox"/>	10	6629132	2003-09-30	Ganguly et al.		709	213
<input checked="" type="checkbox"/>	11	6665674	2003-12-16	Buchanan et al.		707	10

### Remarks

Note: Remarks are not for responding to an office action.

This Information Disclosure Statement is being filed before the mailing date of a first

paper #10 4/5/04



Office Action on the merits. No fee is required. 37 CFR 1.97(b). Documents 2, 3, and 5-8 were cited by the U.S. Patent Office in co-pending Application Serial No. 09/750,315, filed December 29, 2000, in an Office Action dated January 9, 2004. Documents 9-11 were cited by the U.S. Patent Office in co-pending Application Serial No. 10/431,361, filed May 8, 2003, in an Office Action dated February 3, 2004. Documents 1 and 4 were cited by the U.S. Patent Office in co-pending Application Serial No. 09/750,317, filed December 29, 2000, in an Office Action dated March 8, 2004.

Signature

Examiner Name	Date
<i>Kenneth Conkle</i>	<i>6/20/04</i>

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## **USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES**

In support of its 21<sup>st</sup> Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) **provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions** via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) **cease mailing paper copies of U.S. patents and U.S. patent application publications with Office actions** (in applications and during reexamination proceedings) except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications during the international stage.

### **Schedule**

June 2004	TCs 1600, 1700, 2800 and 2900
July 2004	TCs 3600 and 3700
August 2004	TCs 2100 and 2600

All U.S. patents and U.S. patent application publications are available on the USPTO web site. However, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible by phone at 866-217-9197 (toll-free), 703-305-3028 or 703-308-6845 or electronically via the Internet at [ebc@uspto.gov](mailto:ebc@uspto.gov).

### **Other Options**

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide U.S. patents and patent application publications.

*For complete instructions see the Official Gazette Notice, USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES, on the USPTO web site.*

**NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT  
REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE  
ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT  
REFERENCES**

**Summary**

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site ([www.USPTO.gov](http://www.USPTO.gov)) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

**Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References**

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

## Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

### Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at [eReference@uspto.gov](mailto:eReference@uspto.gov) or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer-service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

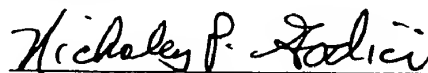
### Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

### For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Date. 12/1/03



Nicholas P. Godici  
Commissioner for Patents